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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,074	02/05/2001	Hironori Kobayashi	P/3760-2	2704
2352	7590	11/01/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			HAQ, NAEEM U	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/777,074	KOBAYASHI, HIRONORI
	Examiner	Art Unit
	Naeem Haq	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 August 2004.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,7,8 and 10-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4,7,8, and 10-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Response to Amendment***

This action is in response to the Applicant's amendment filed on August 11, 2004. Claims 5, 6, and 9 have been canceled. Claims 1-4, 7, 8, and 10-29 are pending and will be considered for examination.

Applicant's amendment to claims 1, 24, and 29 is sufficient to overcome the Examiner's objection. The objection is hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the negative limitation "...information that is not intertwined with information available from the other electronic agent facilities." This negative limitation lacks proper written description support in the specification.

***Final Rejection***

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-4, 7, 8, 10-16, 18-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US Patent 5,979,757) in view of Perkowski (US 2004/0019535 A1) and further in view of Reber et al. (US Patent 6,032,195).**

Referring to claims 1, 7, 8, 18-20, 23-26, and 29, Tracy teaches a system for effecting procurement of desired items which include products or services or information content, the system comprising: a portable, hand-held user tool, comprising a facility for reading, storing and forwarding identification indicia appearing on the desired items (Figures 2 and 5; column 4, line 1 – column 5, line 46); a central agent facility configured to communicate with a plurality of the user tools and constructed to receive from the hand-held user tools the identification indicia (column 5, line 47 – column 6, line 25); a database associated with the central agent facility that receives the desired item identification information received from the hand-held user tools (column 5, line 66 – column 6, line 7); a data gathering facility associated with the central agent facility which communicates to the suppliers users requests for the desired items and receives information from the suppliers relevant thereto; and wherein the central agent facility communicates to the user tools selective information pertaining to the desired items (column 5, line 66 – column 6, line 25). Tracy does not teach that the database correlates the desired item identification information received from the hand-held user

tools with corresponding supply source information for the desired items available at or from a plurality of suppliers. However, Perkowski teaches a system for retrieving information about a product using a hand-held bar code scanner wherein the item identification information (bar code) received from the hand-held is correlated with corresponding supply source information (page 4, paragraphs [0044] and [0045]; page 13, paragraphs [0130] – page 16, paragraph [0156]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Perkowski into the system of Tracy. One of ordinary skill in the art would have been motivated to do so in order to allow the consumer to communicate directly with the supplier. Tracy and Perkowski do not teach that the central agent facility includes a plurality of user-selectable electronic agent facilities which can be selected by a user with the user tool and which electronic agent facilities are operable independently of one another and capable of providing information that is not intertwined with information available from the other electronic agent facilities. However, Reber teaches a method and system that uses a handheld scanner to read and transmit optical code information (column 3, lines 14-22) to a plurality of software agents stored in a database (Figure 1, items “14”, “60”, and “64”; column 4, lines 5-16, lines 60-67; column 5, lines 1-29). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Reber into the invention of Tracy and Perkowski. One of ordinary skill in the art would have been motivated to do so in order to assist the user in performing various on-line activities as suggested by Reber (column 7, line 60 – column 10, line 42). Finally,

Tracy teaches that the tool is operable in both an on-line and off-line mode (column 3, lines 30-60).

Referring to claim 2, Reber teaches that the mode of operation for the sensor is optical or magnetic (column 2, lines 20-33, line 58 – column 3, line 36). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Reber into the invention of Tracy and Perkowski. One of ordinary skill in the art would have been motivated to do so in order to support a variety of code recognition technologies as suggested by Reber.

Referring to claim 3, Tracy teaches that the sensor is incorporated in a mobile terminal (Figures 4 and 5).

Referring to claim 4, Tracy teaches that the tool has reduced memory requirements (column 3, lines 49-54).

Referring to claims 10-15, Tracy and Perkowski do not teach that the electronic agent facilities are selectable by a user based on agent types. However, Reber teaches a method and system that uses a handheld scanner to read and transmit optical code information (column 3, lines 14-22) to a plurality of software agents stored in a database (Figure 1, items “14”, “60”, and “64”; column 4, lines 5-16, lines 60-67; column 5, lines 1-29). The software agents are selected by a user when a user readers a specific optical code. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Reber into the invention of Tracy and Perkowski. One of ordinary skill in the art would have been motivated to do

so in order to assist the user in performing various on-line activities as suggested by Reber (column 7, line 60 – column 10, line 42).

Referring to claims 16 and 27, Tracy teaches that the customer tool comprises an e-navigator software facility which effects communication with the agent facility (column 3, line 30 – column 5, line 46).

Referring to claims 22 and 28, Tracy, Perkowski, and Reber do not explicitly disclose providing responses to requests from the user tools by communicating to users by means of a communication mode selected from a group including: e-mail, facsimile, letter and automatically triggered voice telephone messages. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate these features into the system and method of the cited prior art. The Applicant has not disclosed that these communication modes provide an advantage, are used for a particular purpose or solve a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with the communication mode of the cited prior art because all these communication modes are capable of conveying the same message. Therefore, it would have been obvious to one of ordinary skill in this art to modify the prior art to obtain the invention as specified in the claims.

**Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US Patent 5,979,757) in view of Perkowski (US 2004/0019535 A1) and Reber et al. (US Patent 6,032,195) and further in view of Jelen et al (US Patent 6,129,276).**

Referring to claims 17 and 21, the cited prior does not teach a automatic triggers, or a navigational facility which monitors the location of the user and provides navigational assistance to the user via the agent facility and the suppliers. However, Jelen teaches these features (column 9, line 56 – column 10, line 17). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Jelen into the system and method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide targeted advertisement to a consumer based on the consumer's location, as taught by Jelen.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,081,629 to Browning is directed to a handheld scanner with a software agent.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

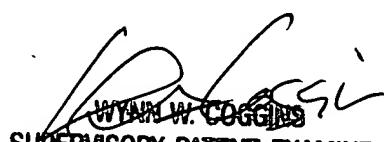
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner  
Art Unit 3625

October 24, 2004



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